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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,205	06/29/2000	Tetsujiro Kondo	112857-104	6606

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BELL, BOYD & LLOYD, LLC  
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EXAMINER
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LEE, RICHARD J

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/607,205

**Applicant(s)**

KONDO, TETSUJIRO

**Examiner**

Richard Lee

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-29, 63-75 and 123-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-29, 63-75, 123-136 and 140 is/are allowed.
- 6) ☒ Claim(s) 137-139 and 141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 137 and 141 are objected to because of the following informalities:

The applicant indicates that Claim 137 as currently shown is previously presented, but the claimed features do not however correspond to claim 137 as previously presented. Specifically, claim 137 lacks the “means for calculating predictive error of the predicted data of the first hierarchy with respect to the image data of the first hierarchy”, “means for determining suitability of the corrected data in accordance with the predicted error”, and “means for outputting the corrected data as the image data of the second hierarchy in accordance with the determined result” as previously presented, thereby rendering claim 137 incomplete. Similarly, claim 141 has been indicated as previously presented, but the claimed features do not however correspond to claim 141 as previously presented. The “first predicting step for generating a prediction value of the first hierarchy, having a plurality of pixels, in accordance with the prediction value of the second hierarchy” as claimed in claim 141 does not correspond to previously presented claim 141, and current claim 141 lacks the “first predicting step for generating predicted data of the second hierarchy, having a plurality of pixels, in accordance with the corrected data of the third hierarchy” and “second predicting step for generating a prediction value of the first hierarchy, having a plurality of pixels, in accordance with the prediction value of the second hierarchy” as previously presented.

Appropriate correction is required.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 137-139, and 141 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 33, 38, and 56 of U.S. Patent No. 6,198,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claims 137-139, and 141 are broader than patented claims 5, 33, 38, and 56, respectively.

The applicant, at pages 17-18 of the amendment filed July 9, 2004, traverses the rejection of claims 137-139 and 141 under statutory double patenting rejection under 35 USC 101 in view of U.S. Patent No. 6,198,770. It is to be noted that claims 137-139 and 141 were however previously rejected, and currently maintained, under a nonstatutory obvious-type double patenting over claims 5, 33, 38, and 56 of U.S. Patent No. 6,198,770. It is emphasized again that the nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. And consequently, the obvious type double patenting rejection on claims 137-139 and 141 is proper since claims 137-139 and 141 are generic and broader than claims 5, 33, 38, and 56, respectively.

4. Claim 137 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,292,591. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because application claim 137 is generic to and broader than patented claim 1.

5. Claims 17-29, 63-75, 123-136, and 140 are allowed.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:


(703) 872-9314, (for formal communications; please mark "EXPEDITED  
PROCEDURE") (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA., Sixth Floor (Receptionist).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Lee whose telephone number is (703) 308-6612. The Examiner can normally be reached on Monday to Friday from 8:00 a.m. to 5:30 p.m, with alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group customer service whose telephone number is (703) 306-0377.

  
RICHARD LEE  
PRIMARY EXAMINER

Richard Lee/rl

11/3/04

